REMARKS

This is a response to an Office Action mailed March 12, 2002. In this response, a provisional election of claims is made and the restriction requirement is traversed. Claims 1-34 are pending in this application.

At paragraph 1 of the Office Action, restriction to one of the two following groups was required under 35 U.S.C. §121:

Group I Claims 10-18 and 20-34, drawn to methods and software encoded media for determining or ranking outcomes in medicine, classified in class 705, subclass 2;

Group II Claims 1-9 and 19, drawn to a data processing system, classified in class 700, subclass 91-92.

(1)

Applicant provisionally elects Group I, but also traverses the restriction requirement below.

The restriction requirement reads in part:

> " Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus ..., or (2) the apparatus as claimed can be used to practice another and materially different process... In this case, the apparatus can be used to practice other materially different processes, such as word processing, scientific calculation, video games, preparation of spreadsheets, or retrieving non-medical website content from the Internet."

Applicant respectfully disagrees because the invention of Group I is not distinct from Group II nor are the inventions of Group I and Group II properly classified in different classes. The embodiments claimed in Group II are the

apparatus equivalents of the method embodiments claimed in Group I. The invention of Group II, as claimed, is drawn to a specific field of technology and cannot be used to practice materially different processes from the methods claimed in Group I. Specifically, the invention of Group II, as claimed, is drawn to medical diagnosis. Applicant fails to see how this apparatus, as claimed, can be used to practice any of the methods provided as examples in the Office Action of word processing, scientific calculation, video games, preparation of spreadsheets, or retrieving non-medical web site content.

Further, Applicant respectfully urges that the invention as claimed in the claims of Group II are misclassified. Class 700, subclasses 91 and 92 are directed toward gaming devices and devices used in competitions. The present invention as claimed is no such device. Accordingly, Applicant respectfully urges that the invention of Group II is misclassified.

This can be seen more particularly in exemplary independent Claim 10 of Group I which comprises:

> "A method for implementing medical studies, the method comprising the steps of:
> selecting a medical study;
> entering medical data related to a patient associated with the medical study;
> immediately processing the medical data entered in combination with other data associated with the medical study using a clinical algorithm specifically designed for the medical study to produce a clinical outcome of the medical study which takes into account the medical data entered that was related to the patient; and
> immediately outputting the clinical outcome data once processed to provide an indication as to how the medical data that was entered for the patient effects, and is related to, the outcome of the medical study."

The above may be compared with exemplary Claim 1 from Group II which comprises:

> " **A digital data processing system for determining clinical outcomes of medical data**, the digital data processing system comprising:
> **an input mechanism receiving sets of medical information**, each set having characteristics relating to a specific medical study and the characteristics of each set having an associated value;
> **a storage mechanism** coupled to the input mechanism, the storage mechanism **receiving and maintaining the plurality of sets of medical information**;
> **a processor** coupled to the storage mechanism, the processor **selecting a first characteristic common to at least two sets of medical information, and processing all values of the first characteristic according to a clinical algorithm to determine a clinical outcome** of the sets of medical information for the specific medical study based upon the selected first characteristic; and
> **an output mechanism** coupled to the processor to receive the clinical outcome of the sets of medical information and **to output the clinical outcome to a user of the digital data processing system such that the user may depend upon the clinical outcome during the course of the medical study**."

Under 35 U.S.C. § 121, restriction may be required if two or more invention that are independent and distinct are claimed in one application. The claims of the present application are directed to a process and the apparatus used in the practice of the process. This subject has been determined to be dependent by law. Therefore, the claims of the present invention are dependent.

Restriction, however, may still be required where the inventions claimed are distinct. According to MPEP §802.01, inventions are not distinct where the

subjects claimed are related as in a process and apparatus for its practice, and where those inventions are patentable over each other. Examiner contends that the inventions of Groups I and II are distinct. Applicant respectfully disagrees.

The requirements for distinctness for a process and its apparatus are given in MPEP §806.05(e). MPEP §806.05(e) reads in relevant part:

> "Process and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (1) that the process as claimed can be practiced by another materially different apparatus or by hand, or (2) that the apparatus as claimed can be used to practice another and materially different process ... The burden is on the examiner to provide reasonable examples that recite material differences."

Applicant respectfully disagrees that the apparatus of the present invention as claimed in the claims of Group II can be used to practice other materially different processes. Further Applicant respectfully urges that the examples of materially different processes provided in the Office Action are unreasonable.

First, the inventions of Group II as claimed are directed toward a medical system, specifically toward implementing the process of determining clinical outcomes of medical data. For example, the apparatus Claim 1 tracks the method Claim 10 clause for clause and each clause of Claim 1 recites a medical purpose. Claim 1, as claimed, practices the method of implementing medical studies of Claim 10 and, as claimed, can practice no other materially different process. Second, Examiner provided as examples of materially different processes word processing, scientific calculation, video games, preparation of spreadsheets, and retrieving non-medical website content from the Internet. Applicant respectfully points out that the apparatus claims of Group II as claimed cannot be used to practice these processes. There is absolutely nothing in the

claims indicating that it is possible to practice word processing, scientific calculation, video games, preparation of spreadsheets, or retrieving non-medical website content. For these reasons, Applicant respectfully urges that the inventions of Group I and Group II are not distinct. Accordingly, the restriction is improper and should be removed.

The restriction requirement further reads in part:

> " Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper."

Where inventions are related and distinct, a restriction requirement may be required where the inventions are classified in separate classes, showing "that each distinct subject has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search." MPEP §808.02.

The inventions of Groups I and II were classified in two separate classifications and Examiner provides this as further support for the restriction requirement, provided that the inventions are distinct, which, as argued above, they are not. Applicant respectfully urges that the invention of Group II is misclassified and should instead receive the same classification as the invention of Group I.

The invention of Group I was classified in class 705, subclass 2. Class 705 is entitled, "Data Processing: Financial, Business Practice, Management, or Cost/Price Determination" and is defined as the generic class for apparatus and corresponding method for performing data processing operations, in which there is significant change in the data or for performing calculation operations wherein the apparatus or method is uniquely designed or utilized in the practice,

administration, or management of an enterprise, or in the processing of financial data. Subclass 2 under class 705 is entitled, "Health Care Management (e.g. Record Management, ICDA Billing)" and is defined as subject matter drawn to a computer implemented system or method particularly adapted for a health care management or delivery organization. Applicant agrees that the invention of Group I is correctly classified in class 705, subclass 2 as the invention is drawn to a health care management system in which medical data is processed.

The invention of Group II was classified in class 700, subclasses 91-92. Class 700 is entitled, "Data Processing: Generic Control Systems or Specific Applications" and is defined as having two main divisions, (A) generic and (B) specific.

The generic class of class 700 is defined as the generic class for the combination of a data processing or calculating computer apparatus (or corresponding methods for performing data processing or calculating operations) and a device or apparatus controlled thereby, the entirety hereinafter referred to as a "control system." Note 5 under Class 700 (A) reads, "Control systems which are limited by the claims to a particular type of process or have a specific utility are classified in the 'Specific Application, Apparatus or Process' area of this class." The invention of Group II has a specific utility and accordingly, Group II is not properly classified under Class 700(A).

The specific class, class 90, part (B) under class 700 is defined as subject matter wherein a data processing or calculating computer apparatus (or corresponding method for performing data processing or calculating operation) is designed for or utilized in a particular art device, system, process or environment, or is utilized for the solution of a particular problem in a field other than mathematics (arithmetic processing per se is classified elsewhere). Note 1 under Class 700(B)(90) reads, "For classification herein, there must be significant claim

recitation of the data processing system or calculating computer and only nominal claim recitation of the external art environment. Where significant structure of the external device is recited by the claims, classification is in the appropriate device class." Applicant respectfully urges that the invention of Group II is not properly classified under Class 700(B) as the claim recites more than nominally to the external art environment, that is, to the medical arts.

Further, Group II was classified under class 700 as belonging to subclasses 91-92. Subclass 91 is entitled, "Contest or Contestant Analysis, Management, or Monitoring (e.g. Statistical Analysis, Handicapping, Scoring)" and is defined as "Subject matter wherein data pertaining to a competition involving physical skill or ability (e.g., an athletic event, etc.), data pertaining to a competition of strategy or chance, or data pertaining to a participant (i.e., contestant) in such a competition, is collected, characterized, or otherwise manipulated for the purpose of determining a state of, a characteristic of, or a condition of the competition or contestant." Subclass 92 is entitled, "Scoring" and is defined as subject matter wherein the number of points, or other grading or rating used to determine the winner of a competition, is calculated or determined from the data. Applicant respectfully points out the invention as claimed in Group II is drawn to a medical diagnosis system and has no aspect either directly claimed, or suggested, drawn to a contest, competition or game. Accordingly, Applicant respectfully urges that not only is Group II misclassified under Class 700, but that it is also misclassified under subclasses 91 and 92. Nor are any other subclasses under class 700(B) appropriate for the invention of Group II.

Applicant respectfully urges that the invention of Group II would be more appropriately classified under class 705, subclass 2, the same classification as the invention of Group I. The invention of Group II is drawn to a health care management system in which medical data is processed. This is, as argued above, the apparatus equivalent of the invention of Group I. Applicant

respectfully urges that the restriction requirement be removed because the inventions of Group I and Group II are not properly classified in separate classes, that in fact they are properly classified in the same class, and therefore do not pose a burden to be examined in the same application.

Lastly, Applicant respectfully urges that the invention of Group I and II are obvious over each other. A restriction should not be required where there is an express admission that the claimed inventions are obvious over each other within the meaning of 35 U.S.C. §103, In re Lee, 199 U.S.P.Q. 108 (Comm'r Pat. 1978). Further, MPEP §803.01 states that it "remains important from the standpoint of the public interest that no requirements be made which might result in the issuance of two patents for the same invention." Applicant respectfully urges that maintaining the present restriction requirement would force a division of claims for the same invention. Therefore, the restriction requirement should be removed.

All objections and rejections having been met, it is believed that the application is in condition for allowance. Favorable action is respectfully solicited.

Applicants hereby petition for any extension of time which is required to maintain the pendency of this case. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 50-0901.

If the enclosed papers or fees are considered incomplete, the Patent Office is respectfully requested to contact the undersigned collect at (508) 366-9600, in Westborough, Massachusetts.

Respectfully submitted,

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